

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

REMARKS

Introduction

Upon entry of the foregoing amendment, claims 1, 2, 4-8, 22-28 and 31-44 are pending in the application. Claims 1, 4, 8, 22-28, 31-32, 37, 41 and 42 have been amended and claim 21 has been cancelled by this Amendment. Claims 43-44 have been added. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

Formal Claim Amendments

Claims 1, 4, 8, 22-28, 31-32, 37, and 42 have been amended in form so that the claim language is consistent throughout the listing of claims. No substantive changes have been made by way of the formal amendments.

Rejection under 35 USC §112

Claims 41-42 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 41-42 have been amended to clearly recite subject matter described in the specification and depicted in the drawings.

Rejection under 35 USC §103

I. Claims 1-2, 4-8, 21-24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over MachASP USB-Software Protection via the USB by Aladdin Knowledge System published October 1998 (hereinafter "MachASP") in view of Chinese Publication No. CN2032364U to Liu (hereinafter "Liu"), and further in view of U.S. Patent No. 6,148,354 to Ban et al. (hereinafter "Ban"). For at least the reasons set forth below, Applicant respectfully traverses the rejections of these claims.

Claim 1

In the Official Action, the Examiner states the position anew that MachASP allegedly discloses a portable memory device for a USB-supporting data processing system. As in the previous Action, the Examiner readily admits that the reference fails to disclose a connector

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

cover capable of sliding backwards upon insertion of the portable memory device, and thus relies on Liu to allegedly teach “an electrical plug having ... a connector cover capable of sliding automatically backwards upon insertion of the electrical plug into an electrical socket and exposing the electrical connector.” See page 3, item 5 of the Detailed Action. The Examiner then asserts that it would have been obvious to one of ordinary skill in the art to incorporate the connector cover of Liu into the USB device of MachASP to “protect the USB connector.” The Examiner also admits that MachASP fails to disclose a USB interface and cites Ban as allegedly showing such.

Applicant renews its previous objection of the Examiner’s apparent improper use of hindsight reconstruction in the application of Liu. This is evidenced by the Examiner’s apparent extraction of features from some unspecified source in the reference, but which are clearly not gleaned from the Abstract, the only English portion of the reference, and the drawings. Nowhere in either the Abstract or the drawings is there an indication that a sliding cover even exists in Liu’s electrical plug. There is certainly no disclosure in the Abstract of such sliding capability of the cover, and the drawings appear to show rigidity in the regions where sliding members would be necessary to enable the cover in Liu to slide in a manner consistent with the recitations of the subject claim. Being that there is no clear teaching by Liu of a sliding cover on the electrical plug therein, the Examiner’s application of Liu can only be made through hindsight, i.e. extrapolating unqualified elements of Liu so as to fit the recitations of claim 1, as well as other pending claims of the subject patent application.

As Applicant has previously argued, there are many features of Liu’s plug that appear to be unsuited for an application consistent with the recitations of independent claim 1. In fact, there appears to be explicit teaching away from the structural arrangement recited in claim 1 by Liu, however the totality of Liu’s teachings cannot be ascertained since the full disclosure thereof is not in English. For example, it cannot be established if the shape of Liu’s plug is necessary to its “being a sealed structure that is contacted in different sections at several times,” (see Liu Abstract) or which portion of the plug moves, or does not move, to ensure that the “switch [is integrated in the plug] such that it is convenient for use,” (see Liu Abstract).

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

Applicant cannot say with certainty what capabilities the connector of Liu has, and neither can the Examiner without a translation of the reference.

As stated in the M.P.E.P §706.02 (II):

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. **Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art.** See Ex parte Jones, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. **If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.** The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that **the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103,** when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP § 706.07(a) (emphases added).

Thus, for at least the reason that Liu fails to properly disclose or teach a “connector cover capable of sliding and automatically backwards upon insertion of the portable memory device

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

into the USB port exposing the USB connector,” as recited in independent claim 1, the reference cannot overcome the Examiner’s admitted deficiencies of MacHASP and Ban. As such, the references, separately or in combination, fail to disclose, teach or suggest all of the elements of the subject claim, and, for at least this reason, cannot make obvious this claim. Accordingly, withdrawal of the rejection and allowance of independent claim 1 are earnestly solicited.

In addition to the evidentiary shortcomings of Liu, but ignoring them for the sake of further discussion, Applicant also renews its objection to the application of Liu on the grounds that it is non-analogous art, and, as such, can only be applied through impermissible hindsight reconstruction. A slidable cover for a large power connector attached to an unwieldy cable, and for which the cover is intended to prevent electrical shock, leaving aside for the moment whether such is in fact disclosed by Liu, would not be a field where an ordinarily skilled artisan in the USB portable memory art, or even in the electrical and mechanical arts in general, would seek a solution for protecting a low voltage signal connector from damage caused from being carried in a pocket or the like. As the Examiner is aware, “It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.” W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). When casting the mind back, and forgetting any prior teaching, and presented with Liu while attempting to solve the problem of damage to a small structure within one’s pocket or as a fob on a key-ring, it is unlikely that one would have the spark of invention, or even recognize a solution from pondering Liu, or any other power connector reference. Indeed, one would not have in mind that the above-indicated solution lies in art depicting other much larger structures that could not possibly be carried in one’s pocket, due to, for example, the size constraints, especially when the structure being scrutinized is a power connector at the end of a bulky power cable. Thus, even when a decisionmaker has placed before them Liu, or any other covered power connector reference or application, it would be unlikely that a solution to the pocket damage problem would be recognized from the references, **unless the decisionmaker had possession of the cover solution in their mind at the time they were presented with the**

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

reference, which is the very definition of hindsight reconstruction.

As the Examiner is also aware, "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In this case, the field of endeavor is portable memory devices, i.e., self-contained modules requiring no data or power cable, and the problem solved is damage to the connector from repeated contact with other items in a pocket or with keys on a shared key-ring. An electrical connector such as allegedly in Liu, and other such power connectors cited by the Examiner, including Powell, et al. (U.S. Patent No. 5,599,196), cited below, name electrical shock prevention as a primary objective. The cover on such power connectors may coincidentally shield the connector from accidental damage in fulfilling its primary objective of safety, but any damage to the power connector would not be incurred through contact with items in a person's pocket or the like, and it would be ludicrous to consider so. As such, a cover on a power connector, even if it prevents damage incidentally, does not address the problem confronting Applicant at the time of the subject invention.

In rebutting Applicant's arguments in the previous Response, the Examiner repeatedly asserts that any judgment on obviousness is in a sense hindsight reconstruction. However, that does not excuse the Examiner from impermissible hindsight, which attempts to fit a reference to the claims with possession of the solution already obtained from Applicant's disclosure. Regardless of the state of the power connector art at the time the subject invention was made, Applicant devised an innovative solution to a problem not found elsewhere in the electrical connector art, namely preventing damage caused by transportation of the connector on one's person, such as in a pocket or on a key-ring.

It is respectfully submitted that the Examiner is engaging in impermissible hindsight reconstruction in the application of Liu as discussed above, and, for at least this reason, the reference cannot be combined with MachASP and Ban in a proper showing of *prima facie* obviousness. Accordingly, withdrawal of the rejection and allowance of independent claim 1 are earnestly solicited.

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

Claims 2, 4-8, and 22-24

Dependent claims 2, 4-8, and 22-24 incorporate all of the elements and limitations of independent claim 1, and, for at least the reason that MachASP, Ban, and Liu, separately and in combination, do not disclose, teach or suggest all of the elements of independent claim 1, dependent claims 2, 4-8, and 22-24 are patentably distinguishable over the references. Accordingly, withdrawal of the rejections and allowance of the subject claims are earnestly solicited.

II. Claims 25-28, 31-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,038,320 to Miller (hereinafter "Miller") in view of U.S. Patent No. 6,292,890 to Crisan (hereinafter "Crisan") and further in view of Liu. Applicant respectfully traverses the rejections for at least the reasons discussed below.

Claim 25

The Examiner contends that Miller discloses "determining if a USB device 40 is connected to the computer (110), (if security is enabled) ... and enable the hard disk drive (after the password entered by the user is verified)..." The Examiner is thus adding qualifiers to the recitations of claim 25 so as to fit Miller thereto, but in the process is disregarding the recitations of the subject claim that do not allow such a fit. For example, the Examiner has failed to address how Miller discloses, teaches or suggests, "booting up the host computer **only when the USB security device is attached to the USB port** of the host **and only when** the password stored in the USB security device matches the password stored in the host computer" (emphases added), as recited in independent claim 25. Miller nowhere discloses such a protective feature and, in fact, teaches away from such. For example, if a computer operates in accordance with Miller's teachings, and that computer does not have a USB, thereby precluding an ability to "boot[] up the host computer only when the USB security device is attached," the computer in Miller is allowed to boot normally. See Miller, column 4, lines 37-38 and FIG. 6. Thus, it is respectfully submitted that for at least the reason that Miller, and the other references cited, fails to disclose "booting up the host computer only when the USB security device is attached", the reference, alone and in combination with the other references cited, cannot make obvious the subject claim.

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

In paragraph 10 of the Official Action, the Examiner states, “[p]lease note that connecting a device prior to power up, booting the host comprising loading an operating system are inherent during the power up and booting of the computer,” and, “[p]lease further note that the claim does not exclude the presence of the step of checking for the enablement of the security and matching of user’s password.” These statements are further evidence that the Examiner is attempting to make the reference fit to the claim recitations, which is improper. Notwithstanding the Examiner’s assertions that the claim recitations do not preclude “checking for the enablement of the security,” the fact that the claim recites “booting up the host computer only when the USB security device is attached to the USB port of the host and only when the password stored in the USB security device matches the password stored in the host computer,” renders such checking superfluous. The Examiner’s further allegation that plugging in a device prior to power up is an inherent feature is immaterial when such plugging in is a feature recited in independent claim 25 to bring about other operations recited therein, but that are not disclosed, taught or suggested in Miller.

The Examiner admits that Miller does not teach “displaying an error message when it is determined that the USB security device is not attached to the USB port of the host” as recited in the subject claim and relies on Crisan as allegedly teaching “that it is common for error to be displayed for error encountered during the boot up process.” See page 7 of the Detailed Action, first paragraph. Regardless of whether the Examiner’s allegations are based in fact, an error message displayed upon a boot-up error does not equate to “displaying an error message when it is determined that the USB security device is not attached to the USB port of the host”, since such is not a “common” determination of a typical system. Indeed, there is no disclosure whatsoever in Crisan directed to determining the presence of a USB security device. But, the fact remains that Crisan fails to overcome the deficiencies of Miller with respect to independent claim 25 and thus cannot make obvious independent claim 25, even when combined with Miller.

The Examiner relies on Liu as allegedly teaching “automatically sliding a cover on said USB security device backward in a direction opposite to a direction of inserting the USB security device into the USB port when the USB security device is attached to the USB port of the host computer,” as recited in claim 25. But, for at least the reasons discussed above with regard to

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

claim 1, Liu fails to disclose such a sliding cover. Liu also fails to overcome the deficiencies of Miller and Crisan, and for at least the reason that Miller, Crisan and Liu, separately and in combination, fail to disclose, teach or suggest the full recitations of independent claim 25, the references cannot make obvious independent claim 25. Accordingly, withdrawal of the rejection and allowance of the subject claim are earnestly solicited.

Claims 26-28 and 31-32

Dependent claims 26-28, and 31-32 incorporate all of the elements and limitations of independent claim 25, and, for at least the reason that Miller, Crisan, and Liu, separately and in combination, do not disclose, teach or suggest all of the elements of independent claim 25, dependent claims 26-28, and 31-32 are patentably distinguishable over the references. Accordingly, withdrawal of the rejections and allowance of the subject claims are earnestly solicited.

III. Claim 33 is rejected under 35 U.S.C. §103(a) as being unpatentable over MachASP in view of Liu and Ban, and further in view of Evidence I: USB Special- The Key to Software and Security by Aladdin Knowledge System published September 1998 (hereinafter "Evidence I"). Applicant respectfully traverses this rejection for at least the reasons given below.

The Examiner cites Ban and Evidence I as allegedly disclosing certain structural details not shown in MachASP and Liu, but both Ban and Evidence I fail to overcome the deficiencies of MachASP and Liu. For example, MachASP, Ban, Evidence I, and Liu, separately and in combination, fail to disclose, teach or suggest "an automatically retractable cover having a rectangular cross-section to protect the USB connector from damage when the portable memory device is not connected to the USB-supporting data processing system," as recited in independent claim 33. Thus, for at least the same reasons that MachASP, Ban, and Liu fail to disclose all of the elements recited in independent claim 33, per the discussion of the similar rejection of independent claim 1, and for the reason that Evidence I does not disclose, teach or suggest the elements not shown by the other references cited, the combination of references cannot make obvious the subject claim. Accordingly, withdrawal of the rejection and allowance of independent claim 33 are earnestly solicited.

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

IV. Claims 34-40 are rejected under 35 U.S.C. §103(a) as being unpatentable over MachASP in view of Liu, Ban, Evidence I, and further in view of U.S. Patent No. 5,599,196 to Powell, et al. (hereinafter "Powell"). Applicant respectfully traverses these rejections for at least the reasons discussed below.

Dependent claims 34-40 incorporate all of the elements and limitations of independent claim 33. For at least the reasons discussed with regard to claim 1 regarding power connectors being non-analogous, Powell does not relieve the deficiencies of MachASP, Liu, Ban and Evidence I. Thus, for at least the reason that MachASP, Ban, Liu, Evidence I, and Powell, separately and in combination, do not disclose, teach or suggest all of the elements of independent claim 33, dependent claims 34-40 are patentably distinguishable over the references. Accordingly, withdrawal of the rejections and allowance of the subject claims are earnestly solicited.

V. Claim 33 is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,671,808 to Abbott, et al. (hereinafter "Abbott") in view of Liu.

The Examiner cites Abbott as allegedly disclosing a portable USB memory device, but admits that Abbott does not teach an automatically retractable cover as recited in claim 33, the disclosure for which the Examiner relies on Liu. However, Liu cannot be properly applied to Abbott for at least the same reasons that Liu cannot be properly applied to MachASP, as discussed above with regard to claim 1. Therefore, Abbott and Liu, separately and combined, do not disclose, teach or suggest the recitations of independent claim 33 and, for at least this reason, cannot make obvious this claim. Accordingly, withdrawal of this rejection and allowance of independent claim 33 are earnestly solicited.

VI. Claims 34-40 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Abbott et al. in view of Liu and further in view of Powell et al.

Dependent claims 34-40 incorporate all of the elements and limitations of independent claim 33. Powell does not relieve the deficiencies of Abbott and Liu and, for at least the reason that Abbott, Liu, and Powell, separately and in combination, do not disclose, teach or suggest all of the elements of independent claim 33, dependent claims 34-40 are patentably distinguishable over the references. Accordingly, withdrawal of the rejections and allowance of the subject

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

claims are earnestly solicited.

New Claims

Claims 42-43 have been added. No new matter is being introduced and support for the added claims can be found throughout the subject patent application, such as, for example, FIGS. 2A-2C, 4A-4B, 6, and 7, and the descriptions thereof.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 because the claim amendments, including the added claims: (a) place the subject application in condition for allowance (for the reasons discussed herein), (b) do not raise any new issues requiring search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution as indicated in the final Office Action), (c) present the rejected claims in better form for consideration on appeal (should an appeal be necessary), and (d) are necessary and were not earlier presented because they are made in response to arguments raised in the final Office Action. Accordingly, for at least these reasons, entry of this Amendment is respectfully requested.

Double Patenting

Claims 1, 24, 33-42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting (ODP) as being unpatentable over claims 21, 26-28, 47-49, 51-56 of the copending Application No. 11/410,105. Additionally, claims 2, 4-8, 21-23, 25-28, 31-32 are provisionally rejected on the ground of nonstatutory ODP as being unpatentable over claims 21, 26-28 of copending Application No. 11/410,105, in view of Miller, MacHASP, and/or Ban et al. Applicant acknowledges that the subject claims have been provisionally ODP rejected and defers filing a terminal disclaimer until all other substantive matters have been resolved in this case.

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

Serial No.: 09/685,138
Docket No.: 112-1001
Amendment After Final dated June 4, 2007
Reply to the Final Office Action of April 5, 2007

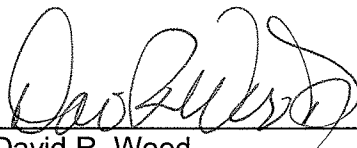
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 502827.

Respectfully submitted,

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